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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,954	07/07/2003	Thomas M. Hohn	30884D	7143

7590 02/11/2005

Larry W. Stults, Ph.D.  
Syngenta Biotechnology, Inc.  
3054 Cornwallis Road  
Research Triangle Park, NC 27709

EXAMINER
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IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,954	<b>Applicant(s)</b> HOHN ET AL.	
	<b>Examiner</b> Medina A Ibrahim	<b>Art Unit</b> 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's response filed 11/15/04 in reply to the Office action mailed 08/13/04 has been entered. This Office action contains NEW GROUNDS OF REJECTIONS not necessitated by Applicant's amendments. Therefore, this action is non-final. The delay in applying these grounds of rejection is regretted.

Claims 1-6 are pending. Claims 1-5 are under consideration. Claim 6 drawn to the non-elected invention of the response of 07/23/04 has been withdrawn from consideration. A complete reply to this Official action must include cancellation of nonelected claim or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

The terminal disclaimer filed on 11/15/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,346,655 has been reviewed and is accepted. The terminal disclaimer has been recorded.

All previous objections and rejections not set forth below have been withdrawn in view of Applicant's amendment.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura et al (The Journal of Biological Chemistry, Vol. 273 (3), January 18 issue, pp. 1654-1661 (1998), Applicant's IDS).

The claims are directed to an isolated nucleic acid molecule comprising a nucleotide sequence that encodes SEQ ID NO: 6, the nucleotide sequence of SEQ ID NO: 5, a chimeric gene comprising a heterologous promoter operably linked to said nucleic acid molecule, and a transgenic host cell comprising the chimeric gene.

Kimura et al teach an isolated nucleic acid molecule from *Fusarium graminearum* encoding Trichothecene 3-O-acetyltransferase which appears to be the same as the claimed nucleotide sequence. Figure 4 on page 1659 shows the nucleic acid molecule comprising the sequence from nucleotide position 1 to nucleotide position 1356 which is 100% identical to SEQ ID NO: 5 (see attached Sequence Search Results). Kimura et al also teach a recombinant vector comprising a chimeric DNA construct comprising the isolated nucleic acid molecule under the control of a heterologous promoter, and transformed host cells expressing said chimeric gene (see page 1657, Figure 3; page 1658, column 1, last full paragraph). Therefore, Kimura et al teach all claim limitations. Applicant is reminded that the novelty of the invention of the claims in the issued patent of US 6,346,655 is the transgenic plant expressing the nucleic acid sequence (for example, SEQ ID NO: 5) and a method for producing said transgenic plant. The instantly rejected claims are not drawn to such a plant or method. Therefore, this rejection is proper.

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**Contact Information**

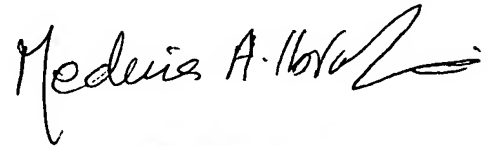
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM . Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mai

2/4/05



MEDINA A. IBRAHIM  
PATENT EXAMINER